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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,731

08/25/2003

Vinayak Shashikant Godbole

839-1372

1167

30024

7590

06/17/2004

NIXON & VANDERHYE P.C./G.E.

1100 N. GLEBE RD.

SUITE 800

ARLINGTON, VA 22201

EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/646,731	GODBOLE ET AL.	
	Examiner	Art Unit	
	R. Alexander Smith	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031016</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "32" appears twice in figure 5 and each seems to designate a different element. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. ~~The replacement sheet(s) should be labeled "Replacement Sheet" in the page header~~ (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1 and 7: As written it is unclear to the examiner if the Applicant is claiming the tool or the tool in combination with turbine casing. For the purpose of this Office action the examiner is treating these phrases as intended use. See the rejections applied below for the specific phrases.

~~*Claim Rejections - 35-USC §102*~~

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4,112,582 to Beckershoff.

Beckershoff discloses the limitations of claim 1 when the outer shell is 1 of figure 1, the inner shell is 2, the tool is 4 with 6, the first section is 6, and the second section 4 is moveably securable to the inner shell.

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With respect to the intended use of the apparatus, i.e., "securable to an inner shell of the turbine casing" in lines 2-3 and "securable to an inner shell of the turbine casing of . . . of the outer shell and the inner shell" in lines 4-9; these intended uses have not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

6. Claims 1, 2, 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4,548,546 to Lardellier.

~~Lardellier discloses the limitations of claims 1 when the outer shell is 12, 10 and 15 of~~
figure 1, the inner shell is 21-24, the tool is 60 with parts 61-66 , the first section is 61, and the second section 63-66 and is securable to the inner shell (via 24, 40 and 25 and 31).

Lardellier discloses top half of the turbine casing being secured to a bottom half of the turbine casing via at least a pair of connecting bolts, e.g., 152 of figure 1, and wherein the first section comprises a pair of openings (at bolt 152) sized and positioned to receive the connecting bolts on the outer shell; wherein the second section comprises a plurality of apertures sized and positioned to receive threaded bolts therein and into existing openings the inner shell. This occurs when the tool also includes shaft 24 with connecting supports 26 and 31, support 31 having the plurality of apertures as shown in figure 1.

With respect to the intended use of the apparatus in claim 1, i.e., "securable to an inner shell of the turbine casing" in lines 2-3 and "securable to an inner shell of the turbine casing of . .

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. of the outer shell and the inner shell" in lines 4-9: these intended uses have not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

With respect to the intended uses of the apparatus in claim 7, i.e., lines 1-4, "extendible across both the inner shell and the outer shell of the turbine casing" in lines 6-8, "sized and positioned to receive the connecting bolts on the outer shell" in lines 9-11, "sized and positioned to receive threaded bolts therein and into existing openings in the inner shell" in lines 13-14, "engageable with the connecting bolts via the pair of openings" in lines 16-17: these intended ~~uses have not been given any patentable weight since it has been held that a recitation with~~ respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckershoff.

~~Beckershoff teaches all that is claimed as discussed in the above rejections of claim 1~~

except for the tool being of formed of steel.

The Applicant's limitations regarding the tool being of steel is only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make the tool disclosed by Beckershoff since they are well known types of materials used to make tools and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshen, 125 USPQ 416. In this case to be able to maneuver the shells without bending or breaking the tool.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lardellier.

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Lardellier teaches all that is claimed as discussed in the above rejections of claims 1, 2, 3 and 7 except for the method steps of claim 11.

With respect to claim 11: the method steps will be met during the normal operation of the tool disclosed by Lardellier. With respect to the planar adjusting mechanism, the adjusting rings 46 in figure 2 are considered to be the mechanism since they accommodate planar adjustment of the shells as demonstrated in figures 3 and 4.

Allowable Subject Matter

11. Claims 4, 5 and 8-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related tools and methods.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

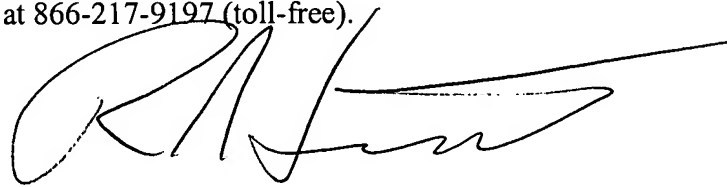
The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal flourish extending to the right.

R. Alexander Smith
Examiner
Technology Center 2800

RAS
June 14, 2004